

REMARKS

The present application includes pending claims 1, 3-4, and 8-28. Claims 8-16 have been withdrawn. Claims 1, 3-4, and 17-28 have been rejected, while claims 27 and 28 have been allowed. By this Amendment, claims 1 and 17 have been amended as set forth above. It is respectfully submitted that the pending claims define allowable subject matter.

The previously filed amendment, which was filed February 25, 2004, was objected to because it allegedly introduced new matter. In particular, the Examiner noted that “a non-twisting manner” was not supported by the original disclosure. The Applicants respectfully traverse this rejection due to the fact that “a non-twisting manner” is disclosed, for example, in Figure 4, which shows a downward force (F) being applied in a linear direction to the handle 270. Such a downward force is clearly applied in a “non-twisting manner.”

The claims were objected to due to typographical errors in numbering. The Applicants thank the Examiner for correcting these typographical errors.

Claim 17 was objected to as being indefinite. The Examiner stated that “Figure 4 illustrates a handle 270 applying a force in a twisting manner.” The Applicants have amended claim 17 to recite that the “force applied to said handle is applied in a linear manner,” as shown by the force arrow F in Figure 4.

Claims 1 and 17 were rejected under 35 U.S.C. 103(a) as being unpatentable over United States Patent No. 2,534,756 (“Corrado”), in view of United States Patent No. 3,601,296 (“Pick”). Claims 3 and 4 were rejected under 35 U.S.C. 103(a) as being unpatentable over Corrado in view of Pick, and further in view of United States Patent No. 5,574,104 (Kolycheck). Claims 18, 20, and 25 stand rejected under 35 U.S.C. 103(a) as being unpatentable over United States Patent No. 4,403,533 (Cox) in view of Kolycheck and United States Patent No. 6,050,167 (Wilhite).

Claim 19 was rejected under 35 U.S.C. 103(a) as being unpatentable over Cox in view of Kolycheck, Wilhite and United States Patent No. 5,820,006 (Turner). Claims 21, 23-24 and 26 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Cox in view of Kolycheck, Wilhite, and Corrado. Claim 22 was rejected under 35 U.S.C. 103(a) as being unpatentable over Cox in view of Kolycheck, Wilhite, Corrado and Pick. The Applicants respectfully traverse these rejections for the reasons set forth previously during prosecution, and for the reasons set forth hereafter.

In order for a *prima facie* case of obviousness to be established, Section 2142 of the MPEP states the following:

First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine the teaching. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest *all* the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art.

Additionally, if a *prima facie* case of obviousness is not established, the Applicants are under no obligation to submit evidence of nonobviousness. *See* MPEP Section 2142 (“The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness.”). The Applicants respectfully submit that (1) the combination of references cited do not teach, nor suggest, each and every limitation of the claims, and (2) there is no suggestion or motivation to combine the references as indicated by the Examiner, and, as

such, a *prima facie* case of obviousness has not been established with respect to the rejection of the pending claims of the present application.

The Applicants first turn to the rejection of claims 1 and 17. Corrado discloses a glazier's tool.

This invention relates to glazier's tools, and more particularly to a hand-operated glass-breaking tool adapted to remove a small block of glass from the edge of a previously cut section of plate glass.

See Corrado at column 1, lines 1-5.

Corrado discloses a "metallic tool shank 13," which, as clearly shown in Figures 1, 3, and 5 of Corrado, is not a plate. In fact, Corrado states, "The numeral 13 indicates generally a *triangular metallic tool shank....*" See *id.* at column 2, lines 2-5 (emphasis added). Because the shank is "triangular", it does not have a recess "of approximately the same width and thickness of the glass." For example, as shown in Figure 4, the tool of Corrado is substantially less wide than the glass. As such, the slot 20 of the tool 13 is by no means approximately the same width and thickness of the glass. Instead, as clearly shown in Figure 4 of Corrado, the width of the tool, and therefore the slot, is not nearly as wide as the sheet of glass. The difference between Corrado and the present application is readily apparent when one compares Figure 4 of Corrado, which shows a relatively narrow tool that is not even close to being as wide as the glass, and Figure 4 of the present application, which shows a slotted plate having a width that is approximately the same width as the glass. Thus, in addition to the Applicant's previous arguments that Corrado does not teach, nor suggest, a "slotted plate," the Applicants respectfully submit that Corrado does not teach, nor suggest, a "slotted plate having upper and lower panel engaging surfaces *defining a recess of approximately the same width and thickness as said glass panel to be separated,*" as recited in claim 1 of the present application.

Pick discloses a system having “strain gauges” 91 and 92 that are affixed to metal shims 102 and 103.

Specifically, a downward pressure on elastomeric pad 86 will result in the compression of the resistance elements 104 and 105 and the placement in tension of the corresponding resistance elements on the bottom surface of the strain gauges 91 and 92.

See Pick at column 4, lines 48-52. As shown in Figure 2 of Pick, for example, the elements 91 and 92 are not attached to a handle.

Overall, the combination of Corrado and Pick does not teach, nor suggest, a “slotted plate having upper and lower panel engaging surfaces *defining a recess of approximately the same width and thickness as said glass panel to be separated*,” as recited in claim 1. Thus, at least for this reason, claim 1, and claims 3-4, and 17, which depend from claim 1, should be in condition for allowance.

Further, as stated above, Corrado relates to a “hand-operated glass-breaking tool adapted to remove a small block of glass from the edge of a previously cut section of plate glass.” See Corrado at column 1, lines 1-5. Pick, on the other hand, relates to a “device for breaking scribed slices of semiconductor material to produce individual bars of the semiconductor material by moving a force applying member.” See Pick at Abstract.

As stated in Section 2143 of the MPEP, “The teaching or suggestion to make the claimed combination and the reasonable expectation of success *must both be found in the prior art, not in the applicant’s disclosure*.” There is nothing in Corrado or Pick that teaches or suggests the use, or even the desirability of, or need for, a force gauge with a glazier’s tool. One having ordinary skill in the art would not be motivated to use the strain gauge of Pick with the hand-held glazier’s tool described in Corrado. There simply is no teaching or suggestion in either reference

to use a strain gauge with a hand-held glazier's tool. In fact, Corrado teaches away from adding additional components to the simple glazier's tool disclosed therein. In particular, Corrado states that "a further object is to provide a device of the above nature which will be *simple in construction, inexpensive to manufacture, easy to install and manipulate, compact, ornamental in appearance, and very efficient and durable in use.*" See Corrado at column 1, lines 16-20 (emphasis added). Adding the strain gauges of Pick to Corrado, at the very least, complicates construction, and adds expense in manufacturing. Thus, at least for this reason, claims 1, 3-4, and 17 should be in condition for allowance.

With respect to claims 3 and 4, Kolycheck relates to "electrostatic dissipating additives based on low molecular weight polyether oligomers which have been reacted with a diisocyanate to form a high molecular weight polymeric material having electrostatic dissipating properties." See Kolycheck at column 1, lines 16-20. Again, the Applicants reiterate that "the teaching or suggestion to make the claimed combination and the reasonable expectation *must both be found in the prior art, not in the applicant's disclosure.*" MPEP 2143 (emphasis added). There simply is nothing in Corrado that indicates any need for using an "electrostatic dissipating additive" with a glazier's tool. Further, Kolycheck does not teach, nor suggest, the use of an "electrostatic dissipating additive" with a glazier's tool. That is, there is nothing in either reference that teaches or suggests combining one with the other. Instead, the Examiner appears to be using the Applicants' disclosure as a roadmap for recreating the claimed invention.

The Applicants now turn to the rejection of claims 18, 20, and 25 as being unpatentable over Cox in view of Kolycheck and Wilhite. "The field of art to which [Cox] pertains is that of reinforced *elastic material*, particularly to the aligning and cutting of an elongate web of such a

material into multiple strips.” See Cox at column 1, lines 5-8 (emphasis added). That is, Cox relates to a system and method of assembling radial tires.

In the method for aligning and slitting an elongate web or reinforced *elastic* material into parallel strips, the improvement includes the steps of aligning the web relative to either its longitudinal center line or one of its edges; keeping the web in a generally flat condition during the aligning step; and restraining the advancing means against lateral movement during the slitting step.

Id. at column 2, lines 36-42 (emphasis added). Notably, Cox does not relate to, nor does it teach or suggest, “a system configured to facilitate separating edge portions for a *glass panel*, in which the *glass panel* floats above a layer of electrostatic dissipative material.” Further, Kolycheck does not teach, nor suggest, this limitation either. Instead, Kolycheck is related to an electrostatic dissipative polymeric composition. Further, Wilhite relates to a “saw table gauge block.” See Wilhite at Abstract. The saw table of Wilhite is used to saw wood, and other such materials, but is not suitable for separating edge portions of a glass panel. Overall, Cox, Kolycheck, and Wilhite, alone or in combination with one another, do not teach, nor suggest, “wherein gas is pumped through said channels along the underside of the glass panel such that the lass panel floats above said layer of electrostatic dissipative material,” as recited in claim 18 of the present application. Thus, at least for this reason, claim 18, and the claims that depend therefrom, should be in condition for allowance at least for this reason. Further, there simply is nothing in any of the references that discloses a “vacuum configured to hold the glass panel tightly against said layer of electrostatic dissipative material.” Again, these references simply do not relate to separating glass. Nor do any of the references teach, or suggest, pumping pure nitrogen along an underside of a glass panel.

Additionally, the Applicants reiterate that “the teaching or suggestion to make the claimed combination and the reasonable expectation *must both be found in the prior art, not in the applicant’s disclosure.*” MPEP 2143 (emphasis added). There simply is nothing in Cox that indicates any need for using an “electrostatic dissipating additive” with an elastic material (such as rubber) slitter. Further, Kolycheck does not teach, nor suggest, the use of an “electrostatic dissipating additive” with such a slitter. Additionally, the saw table gauge block of Wilhite does not relate to a glass separating apparatus. Using such a saw blade on glass would most likely damage or destroy glass. Overall, there is nothing in these references that would motivate one of ordinary skill in the art to combine them. Instead, the Examiner appears to be using the Applicants’ disclosure as a roadmap for recreating the claimed invention. Thus, at least for these reasons, claims 18, 20, and 25 should be in condition for allowance.

With respect to the rejection of claim 19, the Examiner attempts to pick and choose the isolated turntable element of Turner and combine it with Cox, Kolycheck and Wilhite. However, as discussed above, the Applicants respectfully submit that Cox, Kolycheck and Wilhite are not properly combinable. Additionally, Turner relates to “an apparatus and method for scribing and breaking semiconductor wafers and the like into individual dies.” Such a reference is separate and distinct from Cox, Kolycheck and Wilhite. The Applicants respectfully submit that the combination of these four disparate references is improper.

Claims 21, 23-24 and 26 were rejected as being unpatentable over the combination of Cox, which relates to a slitter used for slitting elastic materials such as rubber; Kolycheck, which relates to an electrostatic dissipating additive (but does not teach, or suggest, any relevance in connection with a rubber slitter, glazier’s tool, or the like); Wilhite, which relates to a saw table gauge block that is not suitable for cutting glass; and Corrado, which relates to a simple,

handheld glazier's tool. The Applicants respectfully submit that the disparate nature of these references is clearly evident, as set forth above. As such, these references are not properly combinable. Thus, claims 21, 23-24 and 26 should be in condition for allowance at least for this reason.

With respect to claim 22, the Examiner attempts to add a fifth reference, Pick, to render it obvious. At least for the reasons described above, the Applicants respectfully submit that the addition of Pick to an already improper combination does not render claim 22 obvious.

Overall, the Applicants respectfully submit that the Examiner is using impermissible hindsight to pick and choose isolated elements of non-related references to reject claims of the present application. The MPEP at 2141 states the following:

When applying 35 U.S.C. 103, the following tenets of patent law ***must*** be adhered to:

- (A) The claimed invention must be considered as a whole;
- (B) The references ***must be considered as a whole and must suggest the desirability and thus the obviousness of making the combination;***
- (C) The references ***must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention;*** and
- (D) Reasonable expectation of success is the standard with which obviousness is determined.

See MPEP 2141 at page 2100-116 (emphasis added). As discussed above, there is no suggestion within the references themselves to pick and choose the isolated elements from the disparate references to recreate the Applicants' inventions defined by the pending claims.

Instead, impermissible hindsight is being used to recreate the claimed inventions.

The tendency to resort to "hindsight" based upon applicant's disclosure is often difficult to avoid due to the very nature of the examination process. However, impermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art.

See MPEP at Section 2142.

While the Applicants understand that the use of hindsight may be difficult to avoid, it must, nevertheless, actually be avoided.

It is difficult but necessary that the decisionmaker forget what he or she has been taught... about the claimed invention and cast the mind back to the time the invention was made... to occupy the mind of one skilled in the art who is presented only with the references, and who is normally guided by the then-accepted wisdom in the art.

See MPEP 2141.01 (III) at page 2100-117 (citation omitted).

In light of the above, the Applicants request reconsideration of the application and look forward to working with the Examiner to resolve any remaining issues in the application. If the Examiner has any questions or the Applicant can be of any assistance, the Examiner is invited to contact the Applicants. The Commissioner is authorized to charge any necessary fees or credit any overpayment to Applicants' Deposit Account 07-0845.

Respectfully submitted,

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By: 

Joseph M. Butscher
Reg. No. 48,326
Attorney for Applicants

McANDREWS, HELD & MALLOY, LTD.
500 West Madison Street, 34th Floor
Chicago, Illinois 60661
Telephone: (312) 775-8000
Facsimile: (312) 775 - 8100